

## **REMARKS**

Claims 1 and 15 have been amended to remove references to “step”. No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1, 9, 15, and 28 - 29 are now in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, as claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

### **I. Rejection Under 35 U.S.C. §103(a)**

Page 2 of the Office Action dated July 9, 2007 (hereinafter, “the Office Action”) states that Claims 1, 28, and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2003/0055908 to Brown in view of U. S. Patent Application 2003/0046421 to Horvitz and further in view of U. S. Patent Publication 2004/0172455 to Green. This rejection is respectfully traversed with regard to the claims as currently presented.

Independent Claim 1, as currently presented, recites:

A method of using policy information in responding to arrival of instant messages, comprising:

defining, by an instant messaging (“IM”) user, policy information specifying criteria for responding to arrival of instant messages, wherein the policy information comprises a list of selected application programs which are each distinct from an instant messaging application used by the IM user and which are each executable on a computing device of the IM user;

receiving an instant message from an IM sender who is not already participating in an IM session with the IM user;

programmatically determining, responsive to the receiving, whether any of the selected application programs in the list are currently executing on the computing device of the IM user; and

responding to the arrival of the instant message by opening a new window on a graphical user interface of the computing device of the IM user and displaying the instant message therein if the programmatically determining has a negative result, or by adding an icon representing the instant message to an already-open window but not displaying the instant message itself if the programmatically determining has a positive result, wherein:

the already-open window comprises one of an already-open buddy list window that visually depicts a list of each IM partner from an IM address book of the IM user or an already-open status window that visually depicts a list of each currently-active IM partner of the IM user;

the icon is added in association with a representation, in the visually-depicted list, of the IM sender; and

the icon visually indicates that the instant message is available for on-request display and can be activated by the IM user to cause the on-request display of the instant message. (emphasis added)

Applicants respectfully note that the analysis provided on Page 3 of the Office Action does not use the currently-presented claim language from their Claim 1. As one example, lines 2 - 4 on Page 3 state “... determining based on whether the user is busy or can be bothered, whether the window message should be displayed or just stored”. Applicants have not claimed determining “whether the user is busy or can be bothered”, and also have not claimed that a message “should be displayed or just stored” based upon this determination.

Applicants also respectfully disagree with the analysis of Brown as presented on Pages 2 - 3 of the Office Action. In particular,

- the cited paragraph [0055] (Office Action, Page 2, last 2 lines) appears to Applicants to have no relevance to “defining, by the IM user, policy information ...” (which refers to the recitations of Claim 1, lines 3 - 4). Instead, this cited paragraph discusses various hardware and so forth; and
- Applicants find no discussion in the cited paragraphs [0060], [0067] (Office Action, Page 3, line 4) of “determining ... whether the user is busy or can be bothered”. However, this is a moot point because as noted above, this is not what Applicants have claimed. Instead, the cited paragraph [0060] discusses “each user sending a message request ... may assign a priority value [thereto]” (para. [0060], lines 7 - 9); “each [receiving] user ... provides priority requirements for throughput” (para. [0060], lines 9 - 11); and “determin[ing] ... whether the message request [specifying a priority value] meets that [receiver-specified] priority requirement” (para. [0060], lines 13 - 15, emphasis added). Cited para. [0067] has similar information.

The Office Action admits that Brown “does not explicitly indicate determining whether any of a selected list of application program are active by the IM user ...” (Office Action, Page 3, lines 5 - 6), referring (apparently) to lines 3 - 6 and 9 - 10 of Claim 1. Horvitz is then cited for this teaching (Office Action, Page 3, lines 9 - 14). Applicants respectfully disagree with

this analysis of Horvitz, as will now be discussed.

The Office Action states “Horvitz teaches a system for determining whether to alert the user of incoming IM messages based on a profile that is dynamically created by the system”, referencing Horvitz’s Abstract, and further states “part of that profile is determining the current application the user is working on”, referencing Fig. 34 and “the application in focus”.

With regard to the above-quoted “profile that is dynamically created by the system”, Applicants respectfully submit that their claimed “list of selected application programs” is not “dynamically created by the system”, but is instead “defin[ed] by an instant messaging ... user”. See Claim 1, line 3 (emphasis added).

With regard to the above-quoted “... determining the current application the user is working on”, this is not what Applicants have claimed. Instead, Applicants’ Claim 1 recites “... whether any of the selected application programs in the list are currently executing ...” (Claim 1, lines 9 - 10, emphasis added). The user might have several applications executing simultaneously, for example, and Applicants’ claimed “programmatically determining” as recited on lines 9 - 10 makes no reference to which of those programs the user is currently “working on”. In fact, Applicants’ claim language does not specify that the user is “working on” any of the applications from the list: the user might (for example) be working with his or her instant messaging application while another application or applications from the list is/are

also currently executing (and this IM application is explicitly excluded from the list; see Claim 1, lines 4 - 6).

In summary, Applicants find no teaching, nor any suggestion, in Horvitz of “a list of selected application programs” as recited by Applicants on lines 4 - 6 and lines 9 - 10 of Claim 1. Applicants also fail to find such teaching or suggestion in Green, and the Office Action admits that it is not “explicitly indicate[d]” in Brown.

Accordingly, Applicants respectfully submit that their claim recitations of

- “opening a new window ... if the programmatically determining has a negative result” (Claim 1, lines 12 - 14); and
- “adding an icon ... if the programmatically determining has a negative result” (Claim 1, lines 14 - 16)

which reference this “programmatically determining ...” from lines 9 - 10 of Claim 1 are also not taught or suggested by the cited references.

In view of the above, Applicants respectfully submit that Brown, Horvitz, Green, and any combination thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art would be motivated to attempt it) fails to teach or suggest all of the limitations of independent Claim 1. Claim 1 is therefore deemed patentable over Brown, Horvitz, and/or Green. Independent Claims 28 and 29 specify analogous limitations to those of Claim 1, and are therefore deemed patentable over Brown, Horvitz, and/or Green as well.

In view of the patentability of the independent claims, Applicants respectfully submit that their dependent Claims 9 and 15 are also patentable. The Examiner is therefore respectfully requested to withdraw the §103 rejection of all remaining claims as currently presented.

## II. Conclusion

In conclusion, Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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